

REMARKS

In response to the Office Action of October 17, 2006, Applicants have amended the claims, which when considered with the following remarks, is deemed to place the present application in condition for allowance. Favorable consideration and allowance of all pending claims is respectfully requested. The amendments to the claims have been made in the interest of expediting prosecution of this case. Applicants reserve the right to prosecute the same or similar subject matter in this or another application.

Claims 1-30 are pending in this application. By this Amendment, Claims 1 and 20 have been amended to further define the invention. Support for amended Claims 1 and 20 can be found throughout the specification, e.g., page 4, lines 1-8 and page 23, lines 10-11. Applicants respectfully submit that no new matter has been added to this application nor have any new issues been raised by these amendments. Moreover, it is believed that the amendment to the claims as presented herein places the application in condition for allowance or in better form for consideration on appeal, if one becomes necessary. Accordingly, entry and consideration of the present Amendment is deemed appropriate as it places the application in condition for allowance.

The Examiner has provisionally rejected Claims 10 and 22-23 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over copending U.S. Application No. 10/699,510. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

The Examiner has provisionally rejected Claims 20 and 22-30 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over copending U.S.

Application No. 10/699,507. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

The Examiner has provisionally rejected Claims 20, 22-24 and 26-30 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over copending U.S. Application No. 10/699,508. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

The Examiner has provisionally rejected Claims 1 and 17-18 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over copending U.S. Application No. 10/779,422. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

The Examiner has rejected Claims 1-3, 8-11 and 16-19 under 35 U.S.C. §102(e) as being anticipated by Carey et al. U.S. Publication No. 2004/0144355 ("Carey et al.").

Carey et al. disclose a marine diesel engine system containing a slow-speed cross head marine diesel engine with at least one cylinder; and cylinder lubricant components proximate to the engine and containing (a) a primary lubricant and (b) an additive selected from (i) an alkylamine-alkylphosphate having at least 1.25 equivalents of alkylamine to 1.0 equivalents of alkylphosphate, (ii) 500 TBN calcium sulfonate, and (iii) mixtures thereof. Carey et al. further disclose in Example 2 storage stability data for six different lubricating oil compositions. As set forth in Table II in Carey et al. the six different lubricating oil compositions each contain the same base oil and either (1) no additive (Comparative Example 2); (2) calcium sulfonate as the additive in varying amounts (Example 2 and Comparative Examples 3 and 4); (3) magnesium

sulfonate as the additive (Comparative Example 5) or (4) calcium phenate as the additive (Comparative Example 6).

In contrast to the presently claimed invention, Carey et al. fail to disclose or suggest a combinatorial lubricating oil composition library comprising “a plurality of different lubricating oil compositions comprising (a) a major amount of at least one base oil of lubricating viscosity and (b) a minor amount of at least one lubricating oil additive, wherein the plurality of different lubricating oil compositions is at least 20” as presently recited in amended Claim 1. Thus, the presently recited combinatorial library, as set forth in the present claims, contains at least 20 lubricating oil compositions including many different base oils each of varying types and/or amounts and many different lubricating oil additives also each of varying types and/or amounts. Carey et al. on the other hand simply disclose storage stability data for six different lubricating oil compositions as set forth in Table II therein, one of which does not even contain an additive. As Carey et al do not disclose all of the elements and limitations of the claimed invention, unquestionably, then, the presently claimed combinatorial lubricating oil composition library recites novel subject matter over Carey et al.

For the foregoing reasons, amended Claims 1-3, 8-11, 16-19 are believed to be patentably distinct over Carey et al. and withdrawal of the rejection under 35 U.S.C. §102(e) is respectfully requested.

The Examiner has rejected Claims 1-2, 8-10 and 16-26 under 35 U.S.C. §102(e) as being anticipated by Kolosov et al. U.S. Publication No. 2004/0123650 ("Kolosov et al."). This rejection is respectfully traversed.

According to the Examiner, “[a]lthough a large number of different types of flowable samples are taught by Kolosov et al. as being analyzed in a high throughput manner in a combinatorial library by measuring many different parameters, the fact remains that the disclosure of Kolosov et al. does teach of the analysis of lubricant compositions having additives therein in a high throughput manner by placing many different types of the lubricant compositions in a plurality of receptacles, automatically moving the receptacles to locations for measurement of parameters and measuring many different parameters of the samples including those associated with the long-term stability of the compositions. Therefore, the reference to Kolosov et al. discloses a high throughput method for producing a combinatorial lubricating oil composition library, as well as the library itself.”

It is well established that, for a claim to be anticipated, a single prior art reference must disclose each and every element of the claimed invention, either expressly or inherently. *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 USPQ2d 1766, (Fed. Cir. 1987); *cert. denied*, 484 U.S. 1007 (1988). Kolosov et al. nowhere disclose or suggest a combinatorial lubricating oil composition library comprising “a plurality of different lubricating oil compositions comprising (a) *a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive*” as presently recited in amended Claim 1. Nor, for that matter, does Kolosov et al. disclose or suggest a high throughput method for producing a combinatorial lubricating oil composition library, under program control, comprising (a) providing a library of a plurality of different lubricating oil composition samples comprising (i) *a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive*, each sample being in a respective one of a

plurality of test receptacles; (b) measuring lubricating oil composition properties of each sample to provide lubricating oil composition property data for each sample; and, (c) outputting the results of step (b) as presently recited in amended Claim 20.

Rather, Kolosov et al. simply disclose a system and method for screening a library of a multitude of genera of material samples for rheological properties, one of which may be a lubricant. However, a lubricant can be a grease, jelly, e.g., K-Y jelly, as well as powders, e.g., dry graphite, PTFE, etc., formulated with water and can be used as is such that all lubricants may not even require an additive or, for that matter, be used in a lubricating oil composition. Moreover, a lubricating oil composition can be a concentrate that contains a major amount of a lubricating oil additive and a minor amount of base oil of lubricating viscosity as a diluent for the concentrate. In fact, at no point does Kolosov et al. provide any disclosure that a lubricant can even be a base oil of lubricating viscosity for use in a lubricating oil composition much less a plurality of different lubricating oil composition samples comprising (a) a major amount of at least one base oil of lubricating viscosity and (b) a minor amount of least one lubricating oil additive. Thus, Kolosov et al. do not disclose all of the elements and limitations of the claimed invention. Accordingly, Claims 1, 2, 8-10 and 16-26 clearly possess novel subject matter relative to Kolosov et al. and withdrawal of the rejection under 35 U.S.C. §102(e) is respectfully requested.

The Examiner has rejected Claims 4-7 and 12-15 under 35 U.S.C. §103(a) as being obvious over Carey et al.

The foregoing deficiencies of Carey et al. discussed above with respect to the rejection of Claim 1, from which Claims 4-7 and 12-15 ultimately depend, apply with equal force to this

rejection. At no point is there any suggestion, motivation or even a hint in Carey et al. of providing a combinatorial lubricating oil composition library comprising "a plurality of different lubricating oil compositions comprising (a) a major amount of at least one base oil of lubricating viscosity and (b) a minor amount of at least one lubricating oil additive, wherein the plurality of different lubricating oil compositions is at least 20" as presently recited in amended Claim 1, from which Claims 4-7 and 12-15 ultimately depend.

Instead, Carey et al. merely disclose a lubricating component for marine diesel engines which includes a marine diesel engine lubricant as the primary lubricant and an additive such as a detergent, an antioxidant, a dispersant, a demulsifier, a defoamant or an antiwear additive. Moreover, there must be some teaching or suggestion within the reference, or within the general knowledge of one skilled in the art, to arrive at the claimed invention. If it is the Examiner's position that Carey et al. teach or suggest the claimed combinatorial lubricating oil composition library, the Examiner is respectfully requested to provide with particularity (i.e., by column and line) where in Carey et al. such suggestion and motivation can be found. Certainly, nothing in Carey et al. would lead one skilled in the art to modify the lubricating component for marine diesel engines disclosed therein and arrive at the presently recited combinatorial lubricating oil composition library. Accordingly, Claims 4-7 and 12-15 are believed to be nonobvious, and therefore patentable, over Carey et al. and withdrawal of the rejection under 35 U.S.C. §103(a) is respectfully requested.

The Examiner has rejected Claims 27-30 under 35 U.S.C. §103(a) as being unpatentable over Kolosov et al. in view of Smrcka et al., European Patent No. 1233361 ("Smrcka et al.").

The foregoing deficiencies of Kolosov et al. discussed above with respect to the rejection of Claim 20, from which Claims 27-30 ultimately depend, apply with equal force to this rejection. Smrcka et al. does not cure and is not cited as curing the above-noted deficiencies of Carey et al. and Kolosov et al. Rather, Smrcka et al. is merely cited for its disclosure of storing test results in a data carrier. Accordingly, Claims 27-30 are believed to be nonobvious, and therefore patentable, over Kolosov et al. and Smrcka et al.

For the foregoing reasons, amended Claims 1-30 as presented herein are believed to be in condition for allowance. Such early and favorable action is earnestly solicited.

Respectfully submitted,



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